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08/182,409 01/14/94 BARDEEN K DN1389

TALBOT, B EXAMINER

A1M1/0103

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ART UNIT PAPER NUMBER

8

1112

DATE MAILED: 01/03/95

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined  Responsive to communication filed on 9/30/94  This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1.  Notice of References Cited by Examiner, PTO-892.
2.  Notice of Draftsman's Patent Drawing Review, PTO-948.
3.  Notice of Art Cited by Applicant, PTO-1449.
4.  Notice of Informal Patent Application, PTO-152.
5.  Information on How to Effect Drawing Changes, PTO-1474.
6.

Part II SUMMARY OF ACTION

1.  Claims 1-32 are pending in the application.

Of the above, claims 16, 22-31 are withdrawn from consideration.

2.  Claims 2, 5, 14, 18, 19 have been cancelled.

3.  Claims are allowed.

4.  Claims 1, 3, 4, 6-93, 15, 17, 20, 21, 32 are rejected.

5.  Claims are objected to.

6.  Claims are subject to restriction or election requirement.

7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8.  Formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on . Under 37 C.F.R. 1.84 these drawings are  acceptable;  not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10.  The proposed additional or substitute sheet(s) of drawings, filed on , has (have) been  approved by the examiner;  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed , has been  approved;  disapproved (see explanation).

12.  Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. ; filed on .

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other

EXAMINER'S ACTION

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**Part III DETAILED ACTION**

1. The amendment filed September 30, 1994, has been considered and entered. Claims 2,5,14,18 and 19 have been canceled.

Claim 32 has been added. Claims 1,3,4,6-13,15-17 and 20-32 remain in the application with claims 16 and 22-31 being drawn toward a non-elected invention.

2. Applicant's election of claims 1-15 and 17-21 in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (M.P.E.P. § 818.03(a)). Hence, the restriction requirement is **FINAL**.

3. This application contains claims 16 and 22-31 drawn to an invention non-elected without traverse in Paper No. 7. A complete response to the final rejection must include cancellation of non-elected claims or other appropriate action (37 C.F.R. § 1.144) M.P.E.P. § 821.01.

4. In light of the amendment filed September 30, 1994 the 35 U.S.C. § 102 rejection over Kitabatake has been withdrawn.

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***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Evaluations of the level of ordinary skill in the art requires consideration of such factors as various prior art approaches, types of problems encountered in the art, rapidity with which innovations are made, sophistication of technology involved, educational background of those actively working in the field, commercial success, and failure of others.

The "person having ordinary skill" in this art has the capability of understanding the scientific and engineering principles applicable to the claimed invention. The evidence of record including the references and/or the admissions are considered to reasonably reflect this level of skill.

Claims 1,3,4,6-8,11-13,17,20,21 and 32 are rejected under 35 U.S.C. § 103 as being unpatentable over Kitabatake (4,169,169) and Takiyama et al. (4,490,410).

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Kitabatake teaches a transferring process comprising the steps of: a) providing a transfer sheet comprising a substrate and a pattern layer comprising lower alcohol-soluble, water-insoluble dyes provided on at least one surface of the substrate; b) wetting the pattern layer of the transfer sheet with a transfer solution containing lower alcohols and bringing the transfer sheet into close contact with a receiving surface onto which the pattern is to be transferred in such a manner that the pattern layer contacts the receiving surface; c) maintaining the transfer sheet in close contact with the receiving surface under pressure; and d) peeling the transfer sheet from the receiving surface thereby to leave a transferred pattern corresponding to the pattern of the transfer sheet on the receiving surface (see abstract). The substrate 1 constituting the transfer sheet may be composed of various papers, plastic films or composite films. The pattern layer can be produced by using an ink composition containing lower alcohol-soluble, water-insoluble dyes for example by various printing means. The dyes are non-toxic to the skin (col. 2, line 61 - col. 3, line 69). The transfer pattern contains a solvent which effectively promotes drying at the time of printing and can be dried by natural drying or forced drying (col. 4, lines 43-46). In addition the solvent may be dispersed in water (col. 4, lines 41-42). The transfer solution is applied on the receiving surface onto which the dye pattern is to be

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transferred (col. 4, lines 55-57). The transfer pattern is then applied to the treated receiving surface and when the transfer solution has partly dried, the transfer sheet is peeled from the receiving surface (col. 5, lines 7-19). Further, when the transfer solution contains a resin, an undercoating film is formed under the transferred pattern. This film exhibits an anchoring effect for the receiving surface and at the same time, protects the dye of the transferred pattern (col. 5, line 67 - col. 6, line 15).

Kitabatake fails to explicitly recite that the transferring solution is curable and forms a film on which the pattern is being transferred as well as the use of a "viscous" preparatory layer.

Takiyama et al. teaches a method of coating a stock or shaped body with an active curable resin; placing a pre-printed pattern film so as to contact the resin with the pattern at a stage where the resin still remains in a liquid or sticky gelled state prior to curing, said pattern being printed with an ink having a greater affinity to said resin than said film, irradiating a beam to cure the resin thereby transferring the pattern to cured resin surface, removing the film and thereafter coating the transferred pattern bearing resin surface with a

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translucent film (see abstract). It would have been obvious at the time the invention was made to have utilized Takiyama et al.'s resin transferring layer in Kitabatake's transfer process because of the improved water resistance associated with this type of transferring process as well as the expectation of achieving similar success.

Claims 9,10,15 and 21 are rejected under 35 U.S.C. § 103 as being unpatentable over Kitabatake (4,169,169) and Takiyama et al. (4,490,410) in view of Golchert (4,024,287).

Features described above in rejecting claims 1,3,4,6-8,11-13,17,20,21 and 32 over Kitabatake (4,169,169) and Takiyama et al. (4,490,410) are incorporated here.

Kitabatake and Takiyama fail to teach 1) the active step of drawing the pattern on the transfer sheet as opposed to using a "pre-printed" sheet, tracing the "pre-printed" pattern, and coloring the pre-painted portions, 2) a transfer solution comprising a "stick" glue, paste or egg white and 3) the transfer pattern being a water-soluble ink.

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Golchert teaches a method of decorating food items by placing a transparent shield over a selected design to be transferred to the food item. placing a sheet of thin transfer medium over the shield and design to be traced, tracing said design on the transfer medium using edible ink, placing the medium on the food item to be decorated with the colored side down, and placing a damp pad on the exposed back face of the transfer medium, thereby causing the traced design to be transferred to the food item (see abstract). The design is either drawn originally or traced onto a sheet of transfer medium, using various colors of water soluble edible type ink material (col. 1, lines 52-55). Thereafter the decorator may proceed to use colored frosting or gels to fill in the design (col. 65-67). It would have been obvious at the time the invention was made to have utilized Golchert's method or producing printing transfer patterns for Kitabatake's "pre-printed" transfer patterns because one skilled in the art would be able to capture the decorator "unique" creative designs. In addition, the use of transfer sheets, both "pre-printed" and "designed" are well known in the art. It is the examiner's position that one skilled in the art would have a reasonable expectation of achieving similar success by using "pre-printed" transfer sheets as opposed to "designed" transfer sheets. Therefore, without the showing of unexpected results, the

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difference is considered an obvious modification of one another and is deemed unpatentably distinct.

*Response to Amendment*

6. Applicant's arguments with respect to claims 1, 3, 4, 6-13, 15, 17, 20, 21 and 32 have been considered but are deemed to be moot in view of the new grounds of rejection.

Applicant argued that the term "viscous" surface preparatory composition distinguishes the instant application over the prior art of record.

The examiner respectfully disagrees. Takiyama et al. specifically teaches a method of coating a stock or shaped body with an active curable resin; placing a pre-printed pattern film so as to contact the resin with the pattern at a stage where the resin still remains in a liquid or sticky gelled state prior to curing, said pattern being printed with an ink having a greater affinity to said resin than said film, irradiating a beam to cure the resin thereby transferring the pattern to cured resin surface, removing the film and thereafter coating the transferred pattern bearing resin surface with a translucent film (see abstract and also col. 4, lines 8-15). Takiyama et al. clearly

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teaches a "viscous" layer to which a pattern is transferred thereto.

Applicant has argued that the terms "water soluble" referring to the design pattern and "water based" referring to the surface preparatory composition distinguishes the instant application over the prior art of record.

The examiner respectfully disagrees. While the examiner acknowledges the fact that Takiyama et al., col. 2, lines 31-35, teaches that it is difficult to use water soluble inks, Takiyama teaches that the printed ink with which the decorative pattern (D) is printed should have a greater affinity to the resin than the film on which said ink is printed hereon. Thus no particular limitation of the type of ink should be imposed provided that said ink would have a greater adhesiveness between the ink and the resin than that between the ink and the film (col. 5, lines 1-8).

It is noted that the examiner has taken the position that the use of water soluble inks in combination with water based preparatory surfaces is conventional. The techniques of applying a transfer pattern to a moistened surface or applying a wet material to the back side of a transfer pattern to release the

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pattern are conventional. Applicants claims, as written, are broad enough to read on the prior art of record. If applicant were to claim specific compositions of the surface preparatory material and the type of object to be coated (for example), the examiner would consider withdrawing the rejection, however, the examiner is unaware of the novelty by which the applicant's invention differs from conventional transfer printing. The examiner requests further explanation direct to this point.

7. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

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8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- 1) Paniaguas et al. (5,091,833)
- 2) Caflisch et al. (5,162,138)
- 3) Quinlivan (4,285,978)
- 4) Quikie Cake Transfers

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Talbot whose telephone number is (703) 305-3775.

*Brian K Talbot*

bkt

December 21, 1994

*MBF*  
SHRIVE BECK  
SUPERVISORY PATENT EXAMINER  
GROUP 1100